

Applicant submits that the '222 publication is not prior art as the filing date of the '222 publication, April 25, 2001 is more than seven months after the priority date of the instant application, September 16, 2000. If the Examiner is relying on the provisional filing date from which the '222 publication application was filed, Applicant requests evidence that the written description of the provisional application adequately supports the claims of the non-provisional application. Recent case law holds that the specification of the provisional application must contain a written description of the invention in such full, clear, concise, and exact terms, to enable an ordinarily skilled artisan to practice the invention claimed in the non-provisional application. See, New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co., 298 F.3d 1290 (Fed. Cir. 2002). Without such evidence, Applicant submits that the '222 publication is not prior art and requests that the §102(e) rejection be withdrawn.

Second, the '222 publication fails to teach or suggest all aspects of the claimed invention. The '222 publication is directed to a reticle management system as denoted by the title. The '222 publication defines a reticle as a type of photo mask (*i.e.* negative) used in a lithographic process, which is consistent with the instant application's definition found at page 2, lines 5-6 of the specification and skilled artisans as evidenced by Wolf and Tauber's treatise Silicon Processing for the VLSI Era. Stanley Wolf & Richard N. Tauber, Silicon Processing for the VLSI Era Vol. 1 476 (Lattice Press 1986) (relevant page attached). This treatise defines a reticle as a tool containing a pattern image that must be stepped and repeated in order to expose an entire substrate, whereas a mask is defined as a pattern tool which contains patterns that can be transferred to an entire wafer or to another mask in one exposure. The instant application is directed to mask identification and tracking and likewise distinguishes between masks and reticles as different lithographic patterning tools. (*See*, Specification page 2, line 5). The specification further distinguishes masks from reticles, for example, at page 3, lines 15-17: "Solder bump masks tend to wear down more quickly than reticles due to the frequency of use and the cleanings with harsh chemicals." The claims of the instant application must be analyzed as required by M.P.E.P. §2173.02 in light of the content of the particular application disclosure. As shown by the instant specification and those skilled in the art, the reticles of the '222 publication do not correspond to the masks of the

instant application and the Office Action fails to present a *prima facie* case of anticipation. Applicant requests that the §102 rejection be removed.

Applicant respectfully traverses the §103(a) rejection as the Office Action fails to present a *prima facie* case of obviousness. As discussed above and as acknowledged at page 5 of the Office Action, the '222 publication fails to correspond to the claimed invention. In an attempt to overcome the acknowledged deficiency, the Office Action cites col. 1, lines 32-55 of the '535 reference as teaching using a computer to match a reticle serial number and a wafer lot to an event on a processing line. In fact, the cited portion makes no mention of a reticle or a reticle serial number. The cited references do not alone or in combination correspond to all aspects of the claimed invention.

Moreover, the Office Action fails to present evidence of motivation in support of the proposed modification of the cited '222 publication with the '535 reference. Evidence has not been provided of any teaching or suggestion for using the '222 publication in connection with masks, as claimed in the instant invention, or for modifying the reference to achieve the claimed limitations. While the Office Action asserts that the '222 publication and the '535 reference are analogous as they are both directed to a reticle or mask handling system, this is untrue as discussed above and analogous art is not the standard for modifying a reference. Recent case law indicates that evidence of motivation must be specifically identified and shown by some objective teaching in the prior art leading to the modification. "Our court has provided [that the] motivation to combine may be found explicitly or implicitly: 1) in the *prior art references* themselves; 2) in the knowledge of those of ordinary skill in the art that certain *references*, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, 'leading inventors to look to *references* relating to possible solutions to that problem.'" Ruiz v. A.B. Chance Co., 234 F.3d 654, 57 U.S.P.Q.2d 1161 (Fed. Cir. 2000). The Office Action fails to identify reasons of why one skilled in the art would be led to modify the '222 publication, and does not provide any evidence of factual teachings, suggestions or incentives from the prior art that lead to the proposed modification. Applicant requests that the §103(a) rejection be withdrawn.

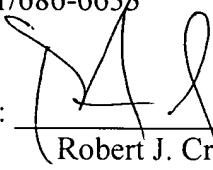
Further, the proposed combination would undermine the purpose of the '222 publication. As discussed above, the '222 publication is directed to a reticle management system that attempts to allow a user to assess current data corresponding to various reticles and to manage the various reticles accordingly. The '535 reference teaches a mask control system and makes no mention of reticles at all. To insert any portion of the '535 reference's mask control system into the reticle management system of the '222 publication would add complexity in the increased number of patterning tools to manage and would increase the amount of time necessary to assess desired reticle data. To allege under §103 that a skilled artisan would modify the '222 publication in such a manner is untenable and impermissible under §103. *See, e.g., In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984) (A §103 rejection cannot be maintained when the asserted modification undermines the purpose of the main reference.)

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

CRAWFORD MAUNU PLLC
1270 Northland Drive, Suite 390
St. Paul, MN 55120
651/686-6633

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By: 
Robert J. Crawford
Reg. No. 32,122

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